REMARKS
Status of the Claims

The Office Action notes claims –2-16, 20-23, 25-29, 31-44, 48-50, 52-59, 63-69, 71-77, and 79-85 as pending in the application. All claims stand rejected.

A.   Rejection under 35 U.S.C. § 102 as being anticipated by U.S. Patent Publication 2002/0065698 to Schick, et. al. ("Schick").

To reject a claim as anticipated by a reference, an examiner must show that the reference discloses each and every element claimed in the rejected claim. Furthermore, the reference must show the claimed elements arranged as in the rejected claim. Lindermann Maschinenfabrik GMbH v. American Hoist and Derrik Co., 730 F.2d 1452, 1458 (Fed. Cir. 1984). Moreover, a reference does not anticipate under 35 U.S.C. § 102 even if it discloses all the elements if it "disclose[s] an entirely different device . . . ." Net Moneyin, Inc. v. Verisign, Inc., 545 F.3d 1359, 1370 (Fed. Cir. 2008), citing Lindermann at 1458. Reiterating the rule from Lindermann, in 2008 the Federal Circuit held in Net Moneyin "that unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102." 545 F.3d 1359, 1371.

Claim 2 in the present application recites in part ". . . (b) processing the data with the computer system to generate diagnostic or location information that is at least in part derived from the received data, wherein the generated information comprises at least one of vehicle status reports and vehicle service recommendations, and wherein the derived information has a meaning distinct from the received data . . . ." The reference cited in the office action does not disclose this element. Furthermore, Applicant traverses the determination made in the office action that the evidence submitted in the 37 CFR sec. 1.131 declaration does not establish a reduction to practice prior to the effective date of the sole reference, Schick, et. al. ("Schick").

In the declaration under 37 CFR sec. 1.131 ("Declaration") submitted in July 2008, Exhibit 4 shows a screen shot of a web site page that displays information related to a vehicle. In addition to data from various sensors, for example fuel pressure, intake manifold pressure, engine RPM, and vehicle speed, the web site page also displays derived information. An example of derived information is the odometer values shown in the column just to the right of the time the data was acquired. Presumably, the date information for each data sample was redacted in the Declaration exhibit for clarity

In paragraph 7 of the Declaration, the inventors declare that the screen shot of the web site shown in Exhibit 4 shows that they reduced to practice the element of deriving and showing derivative data before May 1, 2000. Thus, the previously submitted Declaration provides evidence that the inventors reduced to practice the elements of claim 2, including the element recited above regarding deriving and displaying derivative data,

Notwithstanding that the Declaration provides evidence that the inventors reduced the claimed subject matter to practice before May 1, 2000, the Schick reference does not disclose all of the elements claimed in claim 2. Claim 2 claims processing data received wirelessly at a centrally located computer. The processing includes determining derivative

information from data received from one, or more, monitored vehicles, and then displaying the derivative information. Schick does not disclose this claim element.

On page 3, the present office action erroneously asserts that Schick discloses the element of determining derivative information in paragraph [0025]. In paragraph [0025], Schick describes a processor that processes information in database 39. The information processed includes operation parameter data, and environmental condition data. Such operational and environmental data may be analogous to the data transmitted and received wirelessly from a vehicle to a central location described and included in the subject matter claimed in the present application. Examples from the Declaration that one could analogize to the operation parameter data in Schick are fuel pressure, manifold pressure, and RPM, shown in the screen shot of Exhibit 4.

However, Schick does not discuss deriving information from the operation parameter data to determine derivative information. As an example of derivative information, odometer information may be derived from a directly monitored vehicle speed value divided by a period over which the vehicle speed is monitored. Or, odometer information may be derived from the difference in distance values at two points in time, as determined by, for example, a global positioning satellite ("GPS") circuit in a vehicle device. Since automobile manufacturers do not provide access to odometer information at an on board diagnostics connection, an aspect of the claimed subject matter provides a way to derive the odometer readings from speed and time data, or position data.

Schick does not discuss deriving and using derivative information. Rather, the processing discussed in Schick relates to processing the directly monitored operation parameter data with maintenance information (when a vehicle was repaired, and what was repaired), part number changes from a vehicle manufacture that relate to the vehicle, and design changes issued by the vehicle's manufacturer. [0025]. Indeed, in paragraph [0033], Schick discusses that "[once] data is collected from the mobile assets, it may be used to develop a variety of types of information regarding the mobile assets." Schick continues, stating that the monitored data can be used in comparing to a predetermined range, calculating trends for the monitored data that falls outside the predetermined range, and identifying system faults, etc. All of the uses of the monitored data discussed in the reference perform operations with the monitored data, not information derived from the monitored data.

In reference to the discussion above relative to Exhibit 4 of the Declaration, monitored data in Schick may be analogized to directly monitored and displayed data such as fuel pressure, engine RPM, and vehicle speed data shown in the exhibit. In contrast, derivative information claimed in claim 2 includes using operating parameter data (to borrow terminology from Schick) to derive other information that also indicates operating conditions of the monitored vehicle. Other examples of derivative information include deriving miles per gallon by dividing a distance traveled over a period by the amount of fuel used during the same period. The distance traveled may be determined by changes in GPS coordinates from the beginning to the end of the period. Alternatively, the distance traveled during the period can be derived by multiplying the directly monitored speed during the period by a value representing the period. Another example of determining derivative information is deriving carbon dioxide output from a vehicle. A computer may use values from a mass air flow sensor signal and a value representing the amount of fuel

18

used during a period, or over a certain distance, which as discussed previously, may itself be derivative information. Whatever the derivative information comprises, a common theme in the discussion of derivative information is that directly monitored data (typically data coming from a particular sensor, or circuit in a vehicle) that reflects an operating condition of a vehicle in real time, is used to derive derivative information, that also reflects an operating condition of the vehicle in real time that the vehicle does not monitor directly with a sensor.

Since Schick does not disclose the clamed subject matter of deriving information from directly monitored received data, wherein the derived data has a distinct meaning from the received data (e.g., odometer information has a meaning distinct from directly monitored speed and time data) Schick does not anticipate independent claim 2.

In addition, to the extent that Schick discusses processing received data (directly monitored data received from a vehicle) with other data in database 39, the other data is not data received wirelessly from a vehicle. Rather, the other data comes from sources such as manufacturer updates and maintenance instances. Schick does not discuss that this other information is received wirelessly from a vehicle. Indeed, Schick discusses that maintenance data would be updated when a vehicle is brought to a service center 22 for inspection and maintenance, or when a manufacturer changes a part number, thus implying in paragraph [0025] that the data center 18 does not wirelessly receive the other information wirelessly from the vehicle, but rather from the service center, or from the manufacturer of the vehicle.

Furthermore, even if Schick discloses all of the elements of claim 2, which it does not as discussed above, Schick does not arrange or combine all of the limitations in the same way as recited in the claim because Schick does not disclose that the processor processes data that was wirelessly received from a vehicle. In Net Moneyin, 545 F.3d 1359 at 1371, the Federal Circuit held that a reference that disclosed two internet credit card processing protocols did not anticipate the rejected claims although the reference disclosed all of the claimed links, because the reference did not disclose the claimed arrangement of the links. Thus, as in Net Moneyin, Schick does not anticipate claim 2 because it does not disclose all of the claimed elements arranged or combined as claimed in claim 2.

Summarizing the analysis of the rejection of claim 2, Applicant has shown that the Declaration provides evidence that the inventors had reduced to practice the subject matter claimed in claim 2 before May 1, 2000, because the screen shot in Exhibit 4 illustrates a display that shows derivative information. Thus, Schick cannot serve as a reference in rejecting claim 2. In addition, Applicant has provided analysis above that Schick does not disclose all of the elements of claim 2, because it does not teach deriving derivative information. Furthermore, even if Schick did disclose all of the claimed elements, which it does not, it does not anticipate claim 2 because, assuming for the purposes of discussion that all data in database 39 is received data, the data analyzed at step 48 to produce performance reports is not all wirelessly received from a vehicle. Thus, for at least the reasons discussed above, Schick does not anticipate claim 2 under 35 USC sec. 102. Applicant respectfully requests withdrawal of the rejection of claim 2.

With respect to the rejection under 35 USC sec. 102 of the other independent claims 25, 29, 31, 52, and 63, each of these claims includes the derivative information limitation

analyzed above in reference to claim 2. Thus, Schick does not anticipate any of the independent claims in the present application. Accordingly, Applicant respectfully requests withdrawal of the rejection.

The office action also rejects dependent claims 3-5, 7-16, 20, 22, 32-34, 36-44, 48-49, 53-59, 64, 66-67, 69, 71-77, and 79-85 as being anticipated by Schick. Since these dependent claims all depend from an independent claim that is allowable, as discussed above, they too are allowable because they include all of the limitations of the claim from which they depend. Applicant respectfully requests withdrawal of the anticipation rejection under 35 U.S.C. sec. 102 of the dependent claims.

Notwithstanding that the dependent claims are allowable because they depend from an allowable claim, Applicant addresses rejections of dependent claims below.

With respect to claim 4, Schick does not disclose extracting a VIN from received data as the office action asserts. Indeed, step 30 described in paragraph [0024] refers to a step of a method used by data management system 10 illustrated in FIG. 1. Thus, Schick discloses that identifying a mobile asset occurs as part of using system 10 and method 28. In contrast, a vehicle manufacturer assigns a vehicle identification number ("VIN") at the place and time of manufacture. Thus, since step 30 refers to using a method after the manufacture of a given vehicle, step 30 cannot refer to a VIN. In addition, even if step 30 did refer to a VIN, Schick does not disclose that the VIN is wirelessly received in the received data. Also, Schick does not disclose extracting numerical data, an alphanumeric text message, or an active or pending diagnostic trouble code. Applicant has amended claim 4 to remove the recitation of a GPS determined location. Thus, Schick does not anticipate claim 4. Similar analysis applies to claims 26, 33, and 53. Applicant respectfully requests withdrawal of the rejection of claims 4, 26, 33, and 53.

With respect to claim 5, as discussed above, Schick does not disclose that a communication contains a diagnostic trouble code. In paragraph [0024], Schick describes that analysis of operating parameter data may result in indentifying a critical fault. However, analyzing at a central computer a set of operating data to determine that a fault exists is not the same as wirelessly receiving a diagnostic trouble code ("DTC") in a communication. Thus, Schick does not anticipate claim 5. Similar analysis applies to claims 34 and 54. Withdrawal of the rejection of claims 5, 34, and 54 is respectfully requested.

Notwithstanding that the Schick reference does not disclose receiving a communication containing a DTC, it also does not describe any particular form of DTC, such as 5, 6, or 7 digit DTCs. Thus, Schick does not anticipate claim 6. Similar analysis applies to claim 35. Applicant respectfully requests withdrawal of the rejection of claims 6 and 35.

With respect to claim 14, a mileage value may represent an odometer value with respect to another odometer value. As discussed above, a computer derives odometer values after wirelessly receiving other data, such as speed and time data. Thus, since Schick does not discuss derivative information, Schick does not anticipate claim 14. Similar analysis applies with respect to claim 42. Withdrawal of the rejection of claims 14 and 42 is respectfully requested.

With respect to claims 15 and 16, Schick does not disclose transmitting an alert in a communication. Although Schick discusses determining that a fault has occurred, Schick

does not teach that the fault determination is transmitted in a communication as an alert. Thus, Schick does not anticipate claims 15 and 16. Similar analysis applies to claims 43, 44, and 59. Applicant respectfully requests withdrawal of the rejection of claims 15, 16, 43, 44, and 59.

B.   Rejection under 35 U.S.C. § 103 as being obvious over Schick.

Applicant respectfully submits that the subject matter of the claims patentably distinguishes over the cited references. Under MPEP Eighth Edition (Revision 5, August 2006), § 2143 required that for an examiner to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must not be based on Applicant's disclosure. If any of these three criteria are not met, the Examiner has not met the burden of establishing a *prima facie* case of obviousness, and the rejection should be withdrawn.

As discussed in Federal Register Vol.72, No. 195, Wednesday, October 10, 2007, at page 57527, and reiterated in MPEP Eighth Edition (Revision 6, September 2007), an examiner must continue to find facts under Graham v. John Deere, 383 U.S. 1, (1966). Graham lays out three factual inquires for an examiner to make: (a) determine the scope of the cited reference, (b) ascertain the differences between the references and the claimed invention, and (c) resolve the level of ordinary skill in the pertinent art. This latest revision to the MPEP follows the Supreme Court's decision in KSR International Co. v. Teleflex Inc., 550 U.S. 398 (2007), that "reaffirm[s] the familiar framework for determining obviousness as set forth in Graham []." See PDL Biopharma, Inc. v. Sun Pharm. Indus., 2008 U.S. Dist. LEXIS 105464, par. 92.

Regarding the elements of a *prima facie* case cleanly outlined in previous versions of §2143 of the MPEP, the Supreme Court did not remove the teaching, suggestion, motivation ("TSM") test from obviousness analysis, but merely said that the Federal Circuit errs in applying the TSM test if it uses the test to "transform[] the general principle into a rigid rule that limits the obviousness inquiry." KSR at 419. In addition, although now in separate subsections, MPEP §2143 still discusses each of the three required elements of a *prima facie*. Thus, the three required elements of *prima facie* obviousness still provide a useful framework in analyzing the Graham factors.

Furthermore, according to MPEP § 2145 D, "[i]t is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)." In Grasselli, the applicant claimed a catalyst that contained both iron and an alkali metal. The Grasselli court determined that the claimed subject matter "was not suggested by the combination of a reference which taught the interchangeability of antimony and alkali metal with the same beneficial result, with a reference expressly excluding antimony from, and adding iron to, a catalyst."

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the

reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 27 F.3d 551, 553 (Fed. Cir.1994). In interpreting this language from Gurley, the Federal Circuit stated that "[t]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed . . . ." In re Fulton, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Thus, a reasonable corollary to the Federal Circuit's language in Fulton would be that if a cited reference expressly teaches one embodiment that leads one of ordinary skill in the art in a path that diverges from the claimed invention, then the cited reference teaches away from the claimed invention.

Lastly, regarding rejection of dependent claims, each dependent claim includes all of the limitations of the independent claim from which it depends. If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. In re Fine, 837 F.2d 1071 (Fed. Cir. 1988). Thus, in light of the above, Applicant respectfully submits that the burden of establishing a *prima facie* case of obviousness has not been met, as discussed in the analysis given below.

Except for claims 25 and 29, the office action does not rejected any independent claims as obvious under 35 USC sec. 103. Thus, according to the Federal Circuit in In re Fine, each dependent claim that depend from an independent claim not rejected as obvious is also not obvious.

With respect to the rejection of claim 6, the office action erroneously rejects the claim as obvious over Schick apparently in view of official notice. The office action mentions federal OBD-II regulations that refer to 5 digit codes. However, combining OBD-II specifications with Schick does not provide a suggestion to combine because Schick leads one away from the claimed invention.

In about the middle of paragraph [0031], Schick leads away from the claimed invention in discussing that "[c]omputers and/or personnel located at the data center 18 may analyze the data 48 and identify that the anomaly exists 58 and determine that a maintenance action 60 is recommended." In this passage, Schick teaches that centrally located computers and personnel determine that an anomaly, or fault, exists. This analysis comports with the Federal Circuit's analysis in Grasselli, where a reference which taught the interchangeability of antimony and alkali metal with the same beneficial result combined with a reference expressly excluding antimony from, and adding iron to, a catalyst would lead one away from a catalyst that contained both iron and an alkali metal. In reference to the current rejection in the present application, Schick expressly teaches determining an anomaly at a centrally located location, based on operating parameter data received at the central location. Thus, combining Schick with the official notice regarding OBD-II does not lead to a likelihood of success, because it leads away from wirelessly receiving from a vehicle a diagnostic trouble code that identifies a problem. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 6 and 35, which both claim the same limitation.

Claim 21 depends from claim 2. The office action does not reject claim 2 as obvious, thus claim 21 is not obvious. Withdrawal of the rejection is respectfully requested.

Claim 23 depends from claim 2. The office action does not reject claim 2 as obvious, thus claim 23 is not obvious. Withdrawal of the rejection is respectfully requested.

With respect to the rejection of claim 35, the office action makes an obviousness rejection based on Schick and official notice. In reference to Schick, the office action correctly states that the reference does not disclose that a communication includes a 5, 6, or 7 digit code that describes a diagnostic trouble code. The discussion in Schick regarding diagnostics in paragraph [0035] does not refer to diagnostic trouble codes. As discussed above, in paragraph [0031] Schick teaches away from wirelessly sending diagnostic trouble codes from the vehicle to a central location. Since it would not be obvious to wirelessly send diagnostic trouble codes from a vehicle to a central location, it would not be obvious to wirelessly send a 5-digit diagnostic trouble code from a vehicle to a central location.

Furthermore, claim 35 depends from independent claim 31, which the office action has not rejected as obvious. Thus, claim 35 cannot be obvious under In re Fine. Withdrawal of the rejection of claim 35 is respectfully requested.

With respect to the rejection of claim 50, the claim also depends from independent claim 31. Since the office action does not reject claim 31 as obvious, claim 50 is also not obvious according to Federal circuit precedent In re Fine. Withdrawal of the rejection of claim 50 is respectfully requested.

Claim 25 recites in part ". . . (b) processing the data with the computer system to generate diagnostic or location information that is at least in part derived from the received data, wherein the generated information comprises at least one of vehicle status reports and vehicle service recommendations, and wherein the derived information has a meaning distinct from the received data . . . ." As discussed above in section A of this Amendment, Schick does not disclose determining derivative data that has meaning distinct from the wirelessly received data. Therefore, since the reference does not teach all of the elements, notably elements (b) and (d) recited in claim 25, the patent office has not presented a *prima facie* case of obviousness.

Furthermore, when analyzing the claimed invention as a whole, Schick does not disclose, or infer, that a web site provides one web page for use by end users to view derivative information relative to the user's vehicle, and another web page, from the same web site, that is used by an organization, typically a commercial organization, to view derivative information relative to a plurality of vehicles operated by the organization. Thus, Schick does not disclose this element of claim 25 either. Since the office action has not presented a *prima facie* of obviousness, Applicant respectfully requests withdrawal of the rejection.

The office action rejects claim 26 as obvious for the same reason it rejected claim 4 under 35 USC sec. 102. As discussed above, Applicant has amended claim 4 to remove the reference to GPS. Schick does not disclose any of the other limitations, as discussed above. In addition, claim 25, from which claim 26 depends, is not obvious, as just discussed. Applicant respectfully request withdrawal of the rejection of claim 26.

With respect to claims 27 and 28, claim 25, from which they depend, is not obvious, as discussed above. Thus, claims 27 and 28 also are not obvious. Applicant respectfully requests withdrawal of the rejection of claims 27 and 28.

With respect to the rejection of the claim 29, the claim distinguishes over the references for the same reasons as given above in the analysis of the rejection of claim 25. Namely, Schick does not disclose determining derivative information that is distinct from wirelessly received data. In addition, the reference does not disclose that a first webpage from a web site allows access to, and provides derivative information relative to the vehicle of, a user; and a second web page from the same web site that allows access to, and provides derivative information relative to the vehicles of, an organization. Accordingly, claim 29 patentably distinguishes over the reference, and the Applicant respectfully requests withdrawal of the rejection.

C.   Rejection under 35 U.S.C. § 10 as being obvious over Schick in view of U.S. Patent 6,400,701 to Lin, et. al. ("Lin").

As discussed above, Schick does not disclose determining derivative information that is distinct from received wireless data. The office action has not rejected as obvious claim 63, from which claim 68 depends. In addition, although the office action asserts that Lin discusses the use of WAP for viewing information on a device, Lin makes no reference to WAP. Lin makes multiple references to a wireless link, but not to WAP. Therefore, because the patent office has not rejected claim 63 as obvious, and because Lin does not even mention WAP, claim 68 is not obvious. Withdrawal of the rejection is respectfully requested.
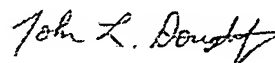
SUMMARY

Applicant respectfully submits that the application is in condition for allowance and that action is earnestly solicited.

If the Examiner believes that there are any issues that can be resolved by a telephone conference, or that there are any informalities that can be corrected by an Examiner's amendment please contact the undersigned at the mailing address, telephone, facsimile number, or e-mail address indicated below.

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